

**Attorney Docket N : 20200/2092 (Serial No.:09/889,802)**

Inventor: Kreutzer, et al.

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Applicants hereby confirm the provisional election with traverse to prosecute the invention of Group I, claims 221-225 and 232-238. Non-elected claims 226-231 are canceled without prejudice. Applicants retain the right to present these claims in a divisional application.

Applicants note the requirement for certified copies of the foreign priority applications. Certified copies of these documents will be submitted to the Patent Office prior to grant of the patent pursuant to 35 U.S.C. 119(b)(3).

#### Objections to the Claims

The Office Action states that claims 240, 244, 246, and 247 are free of the prior art, but are objected to as being dependent upon a rejected base claim (claims 232 and 221). Applicants have amended the base claims to place them in condition for allowance, as discussed below, thereby obviating this objection.

Claim 243 is objected to because of an improper grammatical phrase ("an" should be "the"). Claims 243 has been amended to correct this error.

#### Objections to the Specification

The Patent Office has objected to the specification because it lacks an abstract as required by 37 CFR 1.72(b). Applicants have amended the specification to include an abstract.

The disclosure is objected to because the description of figure 4B-4E is missing. Applicants have amended the specification to include a brief description of this figure.

The disclosure is objected to because of various informalities. Specifically, the specification at page 1, line 5, and page 2, lines 31-33, refers to claims. Applicants have incorporated the content of the claims into the specification as suggested by the Examiner, thereby obviating this objection. The disclosure is also objected to because it lacks headings. Applicants have amended the specification to include proper headings in compliance with the guided formalities.

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The Rejection Under 35 U.S.C. § 112, second paragraph

Claims 241 and 242 were rejected under 35 U.S.C. § 112, second paragraph, because claim 241 depends on itself. Claim 241 has been amended to properly depend from pending claim 221, thereby obviating the rejection.

The Rejections Under 35 U.S.C. § 102

Claims 221, 222, 224, and 243 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Skimkets et al., U.S. Pat. No. 6,486,299. Applicants note that claims that 240 and 246, which require a 3' overhang, are deemed free of the prior art. Although Applicants do not acquiesce to this rejection, claim 221 (from which claims 222, 224 and 243 depend) has been amended to include this limitation, thereby obviating the rejection.

Claims 221-223, 232-236, and 243 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Fire et al., U.S. Pat. No. 6,506,559. Applicants note that claims that 240 and 246, which require a 3' overhang, are deemed free of the prior art. Although Applicants do not acquiesce to this rejection, claim 221 (from which claims 222, 223, and 243 depend) and claim 232 (from which claims 233-236 depend) have been amended to include this limitation, thereby obviating the rejection.

In light of the foregoing amendment and remarks, Applicants respectfully request that the rejections under 35 U.S.C. §102(e) be reconsidered and withdrawn.

The Rejection Under 35 U.S.C. § 103

Claims 221, 232, 239, and 245 have been rejected under 35 U.S.C. § 103 as being unpatentable over Fire et al. (U.S. Pat. No. 6,506,559) taken with Pasloske et al. (U.S. Pat. No. 5,939,262). Applicants note that claims that 240 and 246, which require a 3' overhang, are deemed free of the prior art. Although Applicants do not acquiesce to this rejection, claims 221 and 232, from which claims 239 and 245 depend, respectively, have been amended to include this limitation, thereby obviating the rejection.

Claims 221, 224, 225, 232, 237, and 238 have been rejected under 35 U.S.C. § 103 as being unpatentable over Fire et al. (U.S. Pat. No. 6,506,559) taken with Jaschke et al.

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(*Nucleosides & Nucleotides* (1996) 15:1519-1529). Applicants note that claims that 240 and 246, which require a 3' overhang, are deemed free of the prior art. Although Applicants do not acquiesce to this rejection, claim 221 (from which claims 224 and 225 depend) and claim 232 (from which claims 237 and 238 depend) have been amended to include this limitation, thereby obviating the rejection.

In light of the foregoing amendment and remarks, Applicants respectfully request that the rejections under 35 U.S.C. §103 be reconsidered and withdrawn.

Applicants submit that in view of the foregoing amendments and remarks, all issues relevant to patentability raised in the Office Action have been addressed. Applicants respectfully request the withdrawal of rejections over the claims of the present invention.

Date: April 20, 2003

Respectfully submitted,

  
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MARKED-UP VERSION OF AMENDMENTS:

Please amend claims 221-225, 232, 241, and 243 as follows:

221. (Amended) An oligoribonucleotide having a double stranded structure (dsRNA), comprising two separate RNA strands, wherein one strand of the dsRNA has a region which is complementary to an RNA transcript of at least a part of a target gene, wherein the region is not more than 49 nucleotides in length, wherein the dsRNA comprises a 3' overhang, and wherein the target gene is a mammalian gene.

222. (Amended) The oligoribonucleotide [dsRNA] of claim 221, having a length of between 15 and 49 base pairs.

223. (New ) The oligoribonucleotide [dsRNA] of claim 221, wherein the RNA transcript is a primary or a processed RNA.

224. (Amended) The oligoribonucleotide [dsRNA] of claim 221, wherein the dsRNA comprises a linker between the two RNA strands.

225. (Amended) The oligoribonucleotide [dsRNA] of claim 224, wherein the linker is a polyethylene glycol linker.

232. (Amended) A mammalian cell comprising an exogenous oligoribonucleotide, wherein the oligoribonucleotide has a double stranded structure (dsRNA) comprising two separate RNA strands, wherein the dsRNA comprises a 3' overhang, and wherein one strand of the dsRNA has a region which is complementary to an RNA transcript of at least a part of a target gene.

241. (Amended) The oligoribonucleotide of claim 221 [241], wherein said 3' overhang is a single nucleotide overhang.

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243. (Amended) A composition comprising the [an] oligoribonucleotide according to claim 221.

(i<sup>r</sup>)